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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,013	11/01/2006	Frederic Bordeaux	283891US3PCT	3935
22850 7590 08/17/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER PERENCE, JAMES M				
ART UNIT 3635		PAPER NUMBER		
NOTIFICATION DATE 08/17/2011		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/563,013

Applicant(s)

BORDEAUX ET AL.

Examiner

JAMES FERENCE

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-35, 38-45 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) 31, 35, 38-44 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30, 32-34, 45, 47-57, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2011 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is a reply to the amendment filed on 05/16/2011. Currently, claims 30-35, 38-45 and 47-60 are pending. Claims 1-29, 36, 37 and 46 have been canceled. Claims 31, 35, 38-44 and 58 have been withdrawn. New claims 59 and 60 have been added. Therefore, claims 30, 32-34, 45, 47-57, 59 and 60 are under consideration.

Drawings

The drawings were received on 05/16/2011. These drawings are objected to for the reasons listed below.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s):

“the at least one reinforcing element comprises, longitudinally, a succession of projecting parts of limited extent” (claim 32).

No new matter should be entered.

The drawings are objected to because the drawings are blurry and difficult to read. The drawings contain elements that are critical to the understanding of the invention which are shaded in a grayscale without dark borders and thus it is difficult to locate certain elements, such as element 9 in Figure 3b.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claim 45: The claim recites the limitation, "which overmolding material, upon expanding, expands away from the glazed element." The limitation is indefinite because it is unclear if "which overmolding material" is the same overmolding material as previously recited in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30, 32-34, 52, 56, 57, 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Huchet (FR 2,814,705).

Referring to claim 30: Huchet provides a glazing unit comprising:

a glazed element 2 provided with a peripheral frame 1, the peripheral frame including:

at least one reinforcing element 5 that reinforces the glazed element (Fig. 2), the at least one reinforcing element having a profile including a web part (apex portion of 5, extending in and out of the page, Fig. 2) arranged parallel or substantially parallel to the glazed element (Figs. 1 and 2), the web part bearing at least two projecting parts (6 upper and 6 lower; Fig. 2) distal to the glazed element (distal treated as being located away from; Fig. 2) and forming a pocket 7, and

plastic 3 overmolded onto the glazed element (Fig. 2) *to connect the at least one reinforcing element to the glazed element (Fig. 2)*, the plastic enclosing at least a portion of the at least one reinforcing element (Fig. 2), wherein:

the pocket formed by the web part and the at least two projecting parts is not open in a direction of the glazed element (Fig. 2).

It is noted that the limitation, "*to connect the at least one reinforcing element to the glazed element*" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Referring to claim 32: As best understood (see drawing objection above), Huchet further provides wherein the at least one reinforcing element comprises, longitudinally, a succession of projecting parts of limited extent (the projecting parts of Huchet are a succession of parts and are longitudinally arranged Fig. 2).

Referring to claim 33: Huchet further provides wherein the at least one reinforcing element comprises two lateral arms (6 upper and 6 lower), each arm of the two lateral arms constituting a projecting part borne by the web part (Fig. 2).

Referring to claim 34: Huchet further provides wherein the glazing unit has a U-shaped profile (Fig. 2) with the concavity of the U facing away from the glazed element (Fig. 2).

Referring to claim 52: Huchet further provides wherein the plastic overmolded onto the glazed element includes polyurethane (page 7, line 1).

Referring to claim 56: Huchet further provides wherein the glazing unit is an automotive glazing unit, or a sunroof (Fig. 1).

Referring to claim 57: Huchet provides a reinforcing element 5 for reinforcing a glazed element of a glazing unit provided with a frame 1 made of overmolded plastic 3, the reinforcing element comprising:

a profile including a web part (apex portion of 5, extending in and out of the page, Fig. 2), at least two projecting parts in a form of lateral arms (6 upper and 6 lower), and a plastic that encloses at least a portion of the web part and the at least two projecting parts (same plastic 3 as above), the web part being *configured to be arranged parallel or substantially parallel to a glazed element (Fig. 2)*, and the web part and the at least two projecting parts defining a pocket 7 that is not open in a direction of the glazed element (Fig. 2).

It is noted that the limitation, "*configured to be arranged parallel or substantially parallel to a glazed element*" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Referring to claim 59: Huchet further provides wherein the plastic overmolded onto the glazed element encloses both a side of the reinforcing element arranged nearest to the glazed element and a side of the reinforcing element arranged furthest from the glazed element (Fig. 2).

Referring to claim 60: Huchet further provides wherein the plastic overmolded onto the glazed element completely encloses the at least one reinforcing element (Fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 45 and 47-51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huchet (FR 2,814,705).

Referring to claim 45: As best understood (see 112 2nd rejection above) Huchet further provides wherein the pocket of the profile is filled with overmolding material 7. Huchet is silent as to the overmolding material expanding away from the glazed element.

However, it appears that the material of Huchet would expand away from the glazed element upon expansion. Further, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use a material in the pocket that is less dense than the other materials such that upon expansion, the overmolding material would expand away from the glazed element in order to prevent the glazed element from breaking, since such a modification would have involved a mere change in known materials. The selection of a known material based on its suitability for its intended use

supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a different solvent that was nonvolatile at room temperature but highly volatile when heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.).

It is noted that the limitation, "upon expanding, expands away from the glazed element" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Referring to claims 47-50: Huchet teaches all the limitations of claim 30 as above and further teaches wherein the material of the reinforcing element is composite plastic (page 7, lines 17-25). Huchet is not specific as to the at least one reinforcing element having a coefficient of linear thermal expansion of above $10^{-5}/^{\circ}\text{C}$ or $5.5556 \times 10^{-6}/^{\circ}\text{F}$, or above that of glass of the glazed element or at least equal to $12 \times 10^{-6}/^{\circ}\text{C}$ or $6.6667 \times 10^{-6}/^{\circ}\text{F}$, or below $8 \times 10^{-6}/^{\circ}\text{C}$ or $4.4444 \times 10^{-6}/^{\circ}\text{F}$.

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to optimize the material of the reinforcing element such that the material has a coefficient of linear thermal expansion of above $10^{-5}/^{\circ}\text{C}$ or $5.5556 \times 10^{-6}/^{\circ}\text{F}$, or above that of glass of the glazed element or at least equal to $12 \times 10^{-6}/^{\circ}\text{C}$ or $6.6667 \times 10^{-6}/^{\circ}\text{F}$, or below $8 \times 10^{-6}/^{\circ}\text{C}$ or $4.4444 \times 10^{-6}/^{\circ}\text{F}$, since such a modification would have involved a mere change in known materials. The selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945) (Claims to a printing ink comprising a solvent having the vapor pressure characteristics of butyl carbitol so that the ink would not dry at room temperature but would dry quickly upon heating were held invalid over a reference teaching a printing ink made with a different solvent that was nonvolatile at room temperature but highly volatile when heated in view of an article which taught the desired boiling point and vapor pressure characteristics of a solvent for printing inks and a catalog teaching the boiling point and vapor pressure characteristics of butyl carbitol. "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.).

Referring to claim 51: Huchet teaches all the limitations of claim 30 as above. Huchet does not explicitly teach wherein the at least one reinforcing element has a thickness of between 1.5 and 5 mm or 0.059055 and 0.19685 in. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to

optimize the thickness of the reinforcing element to be between 1.5 and 5 mm or 0.059055 and 0.19685 in, since such a modification would have involved a mere change in proportion. A change in proportion is generally recognized as being within the level of ordinary skill in the art. In *Gardner v. TEC Systems, INC.*, 725 F.2D 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huchet (FR 2,814,705) in view of Bravet et al. (US 6,265,054) ('Bravet').

Referring to claim 53: Huchet teaches all the limitations of claim 30 as above. Huchet does not explicitly teach wherein the glazed element has a laminated glass, which may or may not be hardened, formed from at least two sheets of glass, with interposition of at least one plastic sheet between two adjacent sheets.

However, Bravet teaches a glazed element which has a hardened laminated glass formed from at least two sheets of glass, with interposition of at least one plastic sheet between two adjacent sheets (claim 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to use a composite glazing material as taught by Bravet in the assembly of Huchet in order to prevent damage to the glazing, since composite glazing materials are known in the art, as taught by Bravet.

It is further noted that the limitation, "may or may not be hardened, formed from at least two sheets of glass, with interposition of at least one plastic sheet between two adjacent sheets" is a product-by-process limitation, and the glazing unit does not depend on the process of making it. Therefore, the claimed glazing unit is not a different and unobvious glazing unit from the combination of Huchet and Bravet.

Referring to claims 54 and 55: Huchet and Bravet teach all the limitations of claim 53 as above. Huchet and Bravet do not explicitly teach wherein the glazed element includes a hardened laminated glass having a total thickness of below 5 mm or 0.19685 in, or below 4 mm or 0.15748 in. However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to optimize the thickness of the reinforcing element to be between 1.5 and 5 mm or 0.059055 and 0.19685 in, since such a modification would have involved a mere change in proportion. A change in proportion is generally recognized as being within the level of ordinary skill in the art. In *Gardner v. TEC Systems, INC.*, 725 F.2D 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

Applicant's arguments with respect to claims 30, 32-34, 45, 47-57, 59 and 60 have been considered but are moot in view of the new ground(s) of rejection, as applicant has amended the claims. Accordingly, a new rejection with new references has been formulated to address the amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES FERENCÉ whose telephone number is

(571)270-7861. The examiner can normally be reached on Monday - Thursday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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